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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,113	05/09/2001	Shinichi Kanna	Q64410	2319

7590 03/13/2003  
SUGHRUE, MION, ZINN, MACPEAK & SEAS PLLC  
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Washington, DC 20037

EXAMINER

ASHTON, ROSEMARY E

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/851,113

Applicant(s)

KANNA ET AL.

Examiner

Rosemary E. Ashton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8 and 10-15 is/are rejected.
- 7) ☒ Claim(s) 3 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,2,4-6,8,10-15 are rejected under 35 U.S.C. 102(e) as being anticipated by

Kodama et al U.S. patent no. 6,485,883.

Kodama teaches a positive photoresist composition comprising a polymer having acid labile groups, a compound photogenerating (PAG) carboxylic acid, a compound photogenerating sulfonic acid, a solvent, a fluorine or silicon containing surfactant and a basic compound.

The polymer comprises formula II in claim 4 as shown in polymer A-36 in that n is 2 and W is an unsubstituted aryl group. W as an unsubstituted aryl group meets the limitation of claim 12 in that R4 is an unsubstituted aryl group.

The basic compounds are shown on col. 60, lines 45-65 and col. 61, lines 1-67 and the surfactants in col. 64.

The diaryliodonium and triarylsulfonium PAG's giving carboxylic acid are shown in cols. 8-21 with the amount of PAG recited as 0.1 to 20 % by weight as in claim 1 (col. 24, lines 20-25).

The PAG's giving sulfonic acid are diaryliodonium and triarylsulfonium compounds as shown in col. 24-25 in an amount of 4 % by weight as in claim 11 (col. 29, lines 45-49).

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Resin A-7 in col. 67 has 30 mol % of the styrene hydroxyl groups protected with an acid labile group and has a Mw of 6,000. The other resins exemplified also have protected hydroxyl groups in the range of 5 to 45 mol % as in claim 13 and Mw in the range of 3,000 to 80,000 as in claim 14.

*Allowable Subject Matter*

3. Claims 3 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach the specific compounds in claims 3 and 7 in that it does not teach a methylCO<sub>2</sub>, ethyl CO<sub>2</sub> or propylCO<sub>2</sub><sup>-</sup> anion for the PAG generating carboxylic acid or specific onium compounds generating carboxylic acid as in claim 7. Kodama teaches the anions have a fluoro substituent.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosemary E. Ashton whose telephone number is 308-2057. The examiner works a flexible work schedule and can normally be reached M-F between 10:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 308-2303. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.



Rosemary E. Ashton  
Primary Examiner  
Art Unit 1752

rea  
March 10, 2003

**ROSEMARY ASHTON  
PRIMARY EXAMINER**